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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/642,900 | 08/18/2003 | Kevin W. Eyres | 200304043-3 (HPC.0068C2US | 3212 |

| 7590 | 10/25/2006 |
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| EXAMINER |
|---|
| HOMAYOUNMEHR, FARID |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2132 | |

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2"><strong><em>Office Action Summary</em></strong></td><td><strong>Application No.</strong></td><td><strong>Applicant(s)</strong></td></tr>
<tr><td>10/642,900</td><td>EYRES ET AL.</td></tr>
<tr><td></td><td><strong>Examiner</strong></td><td><strong>Art Unit</strong></td></tr>
<tr><td></td><td>Farid Homayounmehr</td><td>2132</td></tr>
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*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on *18 August 2003*.

2a)☐ This action is **FINAL**.      2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

Claims **1-20** have been examined.

## Information Disclosure Statement PTO-1449

1.    No Information Disclosure Statement was submitted by the applicant.

### *Double Patenting*

2.    The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees.   See, *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ

645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In*

*re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and  *In re Thorington*, 418 F.2d

528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be

used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly

owned with this application. See 37 CFR 1/130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.      Claims 1, 9, and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,324,649 (Eyres et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because Eyres discloses:

Eyres claim 1: A computer system for allowing the pre-installation and operation of a software application without entering a key, the computer system comprising: a processor; a mass storage subsystem coupled to the processor; a data transfer device coupled to the processor; the data transfer device for outputting the software application to the computer system; and installation and operating software code residing in a data transfer media, the installation and operating software code, when executed by the processor, performing the steps of: executing the startup code, further comprising the steps of: upon execution of the startup code, determining if a key is stored in the registry; if the key is not stored in the registry, providing a user discernable prompt, the user discernable prompt requesting a key entry; determining if a proper key has been entered; the proper key has been entered, storing the key in the registry; executing the software application, further comprising the steps of: upon execution of the software application, determining if the key is stored in the registry; if the key is stored in the registry, continue execution of the program; if the key is not

stored in the registry providing a user discernable prompt;  the user discernable

prompts requesting a key entry; determining if the proper key has been entered; if the

proper key has not been entered, ceasing execution of the software application;  and if

the proper key has been entered, storing the key in the registry and continue execution

of the program.

Claims 1, 9, and 16 of the instant application are obvious over claim 1 above, as they

produce a software installation method, system or article that requires entering a key

before the software is installed. If the proper key is entered, the installation will continue,

and if the proper key is not entered, a code requires entering the proper code in a later

time.

4.      This obviousness-type double patenting is not a provisional rejection as the

conflicting claims have in fact been patented.

## Claim Rejections - 35 USC § 112

5.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.      Claim 15 is rejected as failing to define the invention in the manner required by

35 U.S.C. 112, second paragraph.

The claim is narrative in form and replete with indefinite and functional or

operational language.  The structure which goes to make up the device must be clearly

and positively specified. The structure must be organized and correlated in such a

manner as to present a complete operative device.

## *Claim Rejections - 35 USC § 102*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.      Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dolphin

(US Patent No. 5,457,746, dated Oct. 10, 1995).

8.1.    As per claim 1, Dolphin is directed to a method of installing software in a system,

comprising: during an installation procedure, providing a user prompt to request entry of

a key (col. 4 lines 39-48. Also note col. 5 line17-20, where "software" is clearly indicated

as one of data that may be stored on a CD, and made available to user for installation);

determining whether an entered key is proper; in response to determining that the

entered key is proper, installing the software in the system and storing the entered key

(col. 6 lines 54 to 58 shows access to data (software installation when the stored data is

a software) and storing of the key when the key is proper); and in response to

determining that the entered key is not proper, installing the software in the system and

enabling activation of first code to prompt for entry of the key at a later time (the

scenario when the proper key is not entered is taught by Dolphin when a key is expired.

According to col. 6 line 58 to col. 7 line 28, when the key is expired (not proper) the

program requires entry of a new key. Therefore when the software was installed, the

program to prompt for entering a key at a later time, must have been initiated).

8.2.    As per claim 2, Dolphin is directed to the method of claim 1, further comprising:

executing the first code; and during execution of the first code, providing another prompt

for entry of a second key (see response to claim 1 and note that a new key (second

key) is required after the first key is expired).

8.3.    As per claim 3, Dolphin is directed to he method of claim 2, further comprising:

determining, by the first code, whether the second key is proper; and not executing the

installed software in response to the second key not being proper (See response to

claim 2, and note that the purpose of verification of a key is to allow or disallow access

and the standard response to entering an improper key is access denial).

8.4.    As per claim 4, Dolphin is directed to the method of claim 3, further comprising

storing the second key in a registry in response to the second key being proper (the

new key (second key) must be stored in the registry so it could be checked if it is

proper).

8.5.    As per claim 5, Dolphin is directed to the method of claim 4, wherein executing

the first code is performed during a startup procedure of the system (As mentioned in

response to claim 1, the first code is performed when the key is expired and an access

request is made. Therefore, the first code is performed during the startup of the

procedure to request an access when the key is expired).

8.6.    As per claim 6, Dolphin is directed to the method of claim 5, further comprising:

during execution of the installed software, providing a prompt for entry of a second key

(col. 4 line 39-55).

8.7.    As per claim 7, Dolphin is directed to the method of claim 6, further comprising:

determining whether the second key is proper; and stopping execution of the installed

software in response to determining that the second key is not proper (per col. 6 line 58

to col. 7 line 28, Dolphin's system check for validity of the key, and if the key is expired,

requires a new key. It is the standard procedure that if an access code is not valid, the

access is denied, which in this case means termination of the software execution).

8.8.    As per claim 8, Dolphin is directed to the method of claim 1, further comprising:

during execution of the installed software, providing a prompt for entry of a second key;

determining whether the second key is proper; and stopping execution of the installed

software in response to determining that the second key is not proper (see response to

claims 1 and 7).

8.9.    The limitations of claims 9-20 are substantially the same as imitations of claims
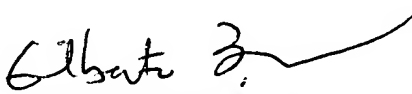
1-8 above.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farid Homayounmehr whose telephone number is 571 272 3739. The examiner can normally be reached on 9 hrs Mon-Fri, off Monday biweekly.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Farid Homayounmehr

Examiner

Art Unit: 2132

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